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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,990	07/03/2001	Mohamed Diab	MASIMO.5CP2C2	3061

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EXAMINER

WINAKUR, ERIC FRANK

ART UNIT PAPER NUMBER

3736

DATE MAILED: 02/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Applicati n No.

09/898,990

Applicant(s)

DIAB ET AL.

Examiner

Eric F Winakur

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 8-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21-26 is/are allowed.
- 6) ☒ Claim(s) 8-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Claim Rejections - 35 USC § 102***

2. The rejection of claims 8 - 13, 15 - 18, and 20 under 35 U.S.C. 102(b) as being anticipated by Branigan is hereby maintained.

#### ***Claim Rejections - 35 USC § 103***

3. The rejection of claims 14 and 19 under 35 U.S.C. 103(a) as being unpatentable over Branigan is hereby maintained.

#### ***Double Patenting***

4. The rejection of claims 8 - 11 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,782,757 is hereby maintained. It is noted that Applicant has offered to prepare a terminal disclaimer to overcome this rejection.

#### ***Response to Arguments***

5. Applicant's arguments filed 4 November 2003 have been fully considered but they are not persuasive. Applicant contends that the finger cots of Branigan suffer from light piping since Figures 9 and 10 show a gap between the surface of the skin and the inside of the finger cot. The gap that Applicant refers to appears to merely be illustrative of the finger positioned within the cot, as the disclosure of Branigan clearly teaches that the finger cot provides a relatively close fit without generating occlusive pressure

(column 5, lines 65 - 67) and distributes compressive forces evenly along the finger (top of column 6) both of which indicate that there is direct contact between the cot and the subject's finger. Applicant's argument against the assertion of inherency is inapt. Applicant argues that since there is no teaching or suggestion of the feature in the reference it cannot be inherent. Yet, if there were such an explicit teaching then an assertion of inherency would not be required. As Branigan illustrates in the embodiment of Figure 8, their device can include apertures (30). It is noted that one embodiment of the claimed obstruction/barrier is an aperture, such as in claims 9 and 11. Applicant's disclosure (pages 45 and 48) suggests that an aperture is effective as an obstruction since it 1) acts to divert light around the circumference of the aperture and 2) prevents a direct line of transmission of light. Since the apertures of Branigan would also perform in this manner, they are considered to inherently (that is, by the intrinsic nature of apertures) meet the claim limitations regarding the optical obstruction. With regard to Applicant's assertion that there is no teaching of an opaque shield with a receptacle (claims 12, 13, 15 - 18, 20), Applicant's attention is drawn to Figures 9 and 10 which show thickened portions of the device which are constructed from opaque materials and receive the emitter and detector. As Branigan teaches, either explicitly or inherently, all of the features of the claim limitations, the rejection of claims 8 - 13, 15 - 18, and 20 is hereby maintained.

With regard to claims 14 and 19 it is noted that Applicant does not argue with Examiner's assertion that it would have been within the skill level of the art to form the cavities of Branigan in a rectangular shape, but merely asserts that they are allowable

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since they are dependent from claims 13 and 18, which Applicant argues are allowable over the prior art. As the rejections of claims 13 and 18 are maintained for the reasons provided in the paragraph above, the rejections of claims 14 and 18 are also maintained.

6. Applicant's arguments, see response page 5, filed 4 November 2003, with respect to the rejection of claims 21 -26 under 35 U.S.C. 112, second paragraph have been fully considered and are persuasive. The rejection of claims 21 - 26 has been withdrawn.

***Allowable Subject Matter***

7. Claims 21 - 26 are allowed.

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

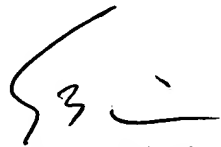
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric F Winakur whose telephone number is 703/308-3940. The examiner can normally be reached on M-Th, 7:30-5; alternate Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 703/308-3130. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703/308-0858.



Eric F Winakur  
Primary Examiner  
Art Unit 3736

29 January 2004